

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JOHN MERVYN CARTER and EDMUND JAMES  
WHITTAKER WEST

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Appeal No. 2001-0584  
Application No. 09/034,067

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ON BRIEF

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Before KRASS, DIXON, and GROSS, Administrative Patent Judges.  
KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-9, all of the pending claims.

The invention is directed to on-line commerce and, more particularly, to a software program which acts as an intelligent agent for users of a client computer. The intelligent agent

shops the web for users by putting together packages for the user based on the user's preferences, also taking into account the significance level given to each item in the package.

Representative independent claim 1 is reproduced as follows:

1. A method of performing computer-based on-line commerce in which a client computer issues a group of interrelated commercial requests and each one of a plurality of server computers is available to service at least one of said requests, said method, performed by an intelligent agent, comprising steps of:

receiving the group of interrelated commercial requests from said client computer;

finding servers which will satisfy said group of requests using client preference levels indicating for each request at least one preferred value which the client would like the agent to use in finding a server to satisfy that request said finding step also uses a client significance level indicating for a corresponding request the relative significance of this request in comparison to the other requests in the group; and

assembling a package of related items which satisfy the group of interrelated commercial requests based on the finding step.

The examiner relies on the following reference:

Janssen	5,754,850	May 19, 1998
		(filed Dec. 10, 1996)

Claims 1-9 stand rejected under 35 U.S.C. 102(e) as anticipated by Janssen.

Reference is made to the brief and answer for the respective

positions of appellants and the examiner.

#### OPINION

It is the examiner's position that Janssen discloses the instant claimed subject matter for the reasons set forth at pages 4-9 of the answer, wherein the examiner identifies the portions of the reference believed to teach each and every claim limitation.

Appellants' position is that while Janssen teaches a computer-based on-line commerce system, Janssen searches through a database which stores a plurality of pre-assembled packages and selects a package best suited to a client's list of preferred attributes. According to appellants, this is in contrast to the instant invention which assembles a package of related items. Thus, it is appellants' position that, unlike appellants' invention, Janssen does not assemble a package of related items but merely searches for an appropriate pre-assembled package which is already part of an existing database.

Appellants also argue that the reference does not teach the step of "finding servers" since the reference is directed to searching a locally stored database in a kiosk and the entire search takes place locally.

We REVERSE.

We do not agree with appellants' argument regarding "finding servers." While Janssen's preferred embodiment relates to locally stored databases in a kiosk, the reference also suggests, at column 8, lines 51-53, that the search system "may be utilized on on-line services." We agree with the examiner that searching on on-line services would inherently entail the finding of servers.

However, we do agree with appellants, and so will reverse the rejection of the claims, that Janssen does not teach or suggest "assembling a package," as claimed. Janssen does produce a package as a result of the search but since all of the packages in Janssen appear to be pre-assembled, with the search merely identifying the most favorable pre-assembled package, Janssen cannot anticipate the claimed subject matter, including "assembling a package," as claimed.

In accordance with the instant disclosure, and appellants' arguments, "assembling a package" is interpreted as actually constructing, or putting together, a package from separate, related items. Since there is no "assembling" in Janssen, because the packages obtained as a result of the search are

already "pre-assembled," Janssen does not teach or suggest this very specific claim limitation.

The examiner contends that the selected items which comprise the search output or result in Janssen are what "constitute the so-called 'package'" [answer-page 11]. However, this is not an accurate statement. In Janssen's example, the search output would be a particular house having all or many of the features desired, but the house already exists. It was not put together for the user of the search system as a result of the search items. The already-existing house was "matched," as closely as possible, to the search items.

Because our interpretation of "assembling a package" precludes a search result constituting an already existing, or a pre-packaged, result, Janssen does not anticipate the instant claimed subject matter.

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Accordingly, the examiner's decision rejecting claims 1-9  
under 35 U.S.C. 102(e) is reversed.

REVERSED

ERROL A. KRASS	)	
Administrative Patent Judge	)	
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	)	
	)	
JOSEPH L. DIXON	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
ANITA PELLMAN GROSS	)	
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